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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/488,381	01/20/2000	Gaetano Bonasia	0267-001-1522	4363

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EXAMINER

MAUNG, ZARNI

ART UNIT	PAPER NUMBER
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2154

DATE MAILED: 11/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application N .

09/488,381

Applicant(s)

BONASIA ET AL.

Examiner

Zarni Maung

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 August 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 1,10-17 and 19-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-9,18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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1. This office action is responsive to the response to restriction requirement filed on August 20, 2003. Applicants provisionally elected claims 2-9 and 18 for examination, with traverse. Claims 1, 10-17, and 19-31 have been withdrawn from consideration.

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made. Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. § 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103.

2. Claims 2-9 and 18 are rejected under 35 U.S.C. § 103 as obvious over Gaucher, U.S. Patent Number 6,175,860 (hereinafter Gaucher).

3. As per claim 2, Gaucher discloses a method of installing and binding a device previously wired into an automation or multimedia network (see abstract, column 2, lines

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48-63). Gaucher discloses the invention substantially as claimed. As per claim 2, Gaucher discloses a method of installing and binding a device previously wired into an automation or multimedia network when said device is the first device to be installed in said network (see abstract, column 2, lines 30-63), said method comprising the steps of:

placing said device in a first-device installation mode of operation (see column 3, lines 22-31, column 5, lines 1-12; new device); assigning to said device a domain ID having an associated length and which is not in use by any other device on said network (see column 3, lines 32-67; unique id code with number sequence); assigning to said device a subnet number and a device ID number (see column 5, lines 35-63, device ID); and, generating an indication to indicate that the device has been added to said network (see column 5, lines 1-28).

4. Gaucher does not explicitly show the indication to indicate that the installation of said device onto said network is complete. However, Gaucher suggested the process of indicating that the device has been added to said network (see column 5, lines 1-28). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify Gaucher by including the indication to indicate that the installation of said device onto said network is complete, because Gaucher suggests the process of indicating that the device has been added to said network. One skilled in the art would have been motivated to modify Gaucher so that a user can see that the device has been successfully installed on the network.

5. As per claim 3, Gaucher discloses the method according to claim 2, wherein said step of placing said device in a first device installation mode of operation comprises pressing an holding a push-button switch on said device (see column 5, lines 35-63, push button switch on VCR is inherent).

6. As per claim 4, Gaucher discloses the method according to claim 2, wherein said step of placing said device in a first device installation mode of operation comprises receiving a command from a local management tool connected directly to said device (see column 5, line 35 to column 6, line 47, command from master computer 12).

7. As per claim 5, Gaucher discloses the method according to claim 2, wherein said step of placing said device in a first device installation mode of operation comprises receiving a command from a remote management tool connected remotely over said network (see column 5, line 35 to column 6, line 47, command from PDA 50).

8. As per claim 6, Gaucher discloses the method according to claim 2, wherein said step of placing said device in a first device installation mode of operation comprises setting a visual or audible indication confirming that said device is in said installation mode of operation (see column 5, line 35 to column 6, line 47).

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9. As per claim 7, Gaucher discloses the method according to claim 2, further comprising the step of generating an error indication if said device was previously installed (see column 9, lines 9-65).

10. As per claims 8-9 and 18, Gaucher discloses the method according to claim 2, wherein said step of assigning to said device a domain ID comprises the steps of querying said network using said assigned domain ID (see column 5, lines 35-66, column 7, line 20 to column 9, line 49); listening for a response to said query and assigning a new domain different than the original domain in the event a response is received within a predetermined time period (see column 5, lines 35-66, column 7, line 20 to column 9, line 49). Gaucher does not explicitly show the process of assigned new domain ID as claimed; however, Gaucher teaches the process of assigning new frequency domain in the event a response is received within a predetermined time period (see column 7, line 20 to column 9, line 49). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify Gaucher by including the process of assigning new domain ID, because Gaucher teaches the process of assigning new frequency (see column 7, line 20 to column 9, line 49).

11. Applicants' arguments filed on August 20, 2003 have been fully considered but they are not persuasive. As per applicants' argument filed on August 20, 2003. The applicants argue that the invention is not directed to multiple methods.

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In reply, claims 1 is directed to a method of adding a device including the steps of binding said device as a first device to be bound when the device is to be installed; binding said device as an additional device when said device is not the device to be installed, and binding said device as existing device to be bound when said device was previously installed in a network, classified in **Class 710, subclass 15**. Claims 2-9 and 18 are directed to method of installing and binding a device by placing said device in a first-device installation mode of operation, classified in **Class 709, subclass 222**. Claims 10-17 and 19-20 are directed to a method of installing a device by placing said device in an additional-device installation mode of operation, classified in **Class 709, subclass 221**. Claims 21-26 are directed to a method of installing a device by placing said device in existing-device mode of operation, classified in **Class 709, subclass 250**. Claims 27-31 are directed to method for adding a CEBus compatible device by issuing a connect command to a context and hailing for a house code, classified in Class 710, subclass 8. Inventions are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, claim 1 or invention I is directed to a method for binding a device as a first device to be bound when the device is to be installed; binding said device as an additional device when said device is not the device to be installed, and binding said device as existing device to be bound when said device was previously installed in a network classified in different **Classes/subclasses**. Invention II or claims 2-9 and 18 are directed to method of installing and binding a device by placing said device in a first-device

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installation mode of operation, classified in **Class 709, subclass 222**. Invention III or claims 10-17 and 19-20 are directed to a method of installing a device by placing said device in an additional-device installation mode of operation, classified in **Class 709, subclass 221**. Invention IV or claims 21-26 are directed to a method of installing a device by placing said device in existing-device mode of operation, classified in **Class 709, subclass 250**. Invention V or claims 27-31 are directed to method for adding a CEBus compatible device by issuing a connect command to a context and hailing for a house code, classified in Class 710, subclass 8. And, in this combination, Invention of claims, as claimed does not require the particulars of the subcombination as claimed because the Invention I does not explicitly require all the detailed limitations recited in claims 2-31. More specifically, Invention I does not require to place the device in one particular mode and does not require by issuing a connect command to a context and hailing for a house code. The subcombination has separate utility such as placing the device in a one of specified mode of operation and issuing a connect command to a context and hailing for a house code, classified in a different Class/Subclass. See M.P.E.P. § 806.05(d). Inventions II, III, IV and V also have separate utilities. Therefore, the restriction requirement is proper and is final.

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. .

a) Device management system for managing standards-compliant and non-



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compliant network elements using standard management protocols and a universal site server which is configurable from remote locations via internet browser technology by Krishnamurthy et al., U.S. Patent Number 6389464.

b) Dual mode serializer-deserializer for data networks by Wang et al., U.S. Patent Number 6516952.

c) Automated appliance control system by Ivie et al., U.S. Patent Number 5815086.

d) Home audio/video network for generating default control parameters for devices coupled to the network, and replacing updated control parameters therewith by Lea, U.S. Patent Number 6052750.

e) method and apparatus for monitoring controlling and configuring local communication devices by Collin et al., U.S. Patent Number 6314475.

f) Local area networking of serial intelligent cells by Binder, U.S. Patent Number 6480510.

### ***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zarni Maung whose telephone number is (703) 308-6687. The examiner can normally be reached on Monday-Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng-Ai An, can be reached on (703) 305-9678. The fax phone number for this Group is (703) 308-9052. Additionally, the fax numbers for Group 2100 are as follows:

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Official Faxes: (703) 872-9306

After Final Responses: (703) 746-7238

Draft Responses: (703) 746-7240

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist at (703) 305-3900.

October 23, 2003